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In the Supreme Court of the United States

OCTOBER TERM 1958

No. 932

GIBSON-STEWART COMPANY, INC.,
Defendant-Petitioner

vs.

WM. BROS BOILER AND MANUFACTURING COMPANY
(NOW BY CHANGE OF NAME BROS INCORPORATED)
Plaintiff-Respondent

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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middle of which extends through and is rigidly secured in a fore-and-aft extending beam 25. The ends of the beams 25 are oscillatably mounted in opposed bearings 26 in transversely extending bearing beams 26a rigidly secured to the lower ends of the recess wall 10. The beams 25 in addition to mounting the shafts 24 operate to maintain parallelism between the lower ends of the recess wall 10, retain proper spacing between said lower ends and cooperate with the fore-and-aft supports to provide a reinforcement for the wall of the arched recess. It will thus be evident that the total weight of the loaded box will be equally imposed, transversely, upon the two beams 25, as they are equally spaced from the transverse center of the machine, and that the load imposed upon the tires.

It is understood that suitable changes or modifications may be made in the design and details of construction as herein disclosed, provided such changes or modifications come within the spirit and scope of the appended claims. Having now therefore fully illustrated and described the preferred embodiments of our invention what we claim to be new and desire to protect by Letters Patent is:

1. An earth compaction roller comprising a hollow body member adapted to receive weight producing ballast and having a transversely extending arched recess between its front and rear ends, an axially aligned series of pneumatic tired wheels mounted in said recess to support the

• **Other advantages**—Aside from cost, the advantages now apparent from the use of pneumatic rollers may be summarized as follows:

1. A type of roller has been developed that is suitable for the compaction of a wide range of both granular and cohesive soils to the densities required by design criteria.

the entire surface.

In recognition of these limitations, specifications issued by the Portland District of the Corps of Engineers in 1947 for construction of Dorena Dam in western Oregon required the contractor to compact the gravelly materials containing cobbles in layers of 9-in. thickness in the random section with six passes of a highway roller having a pressure of 325 lb per inch of tread width.

Because of the difficulty of maintaining adequate moisture control in the cohesive soils, the new rollers were used first in the construction of a series of test fills of silt and clay in order to compare results with those obtained from the previous test fill program with sheepsfoot rollers. They were loaded to 70,000 lb, or 17,500 lb per wheel. The tire pressure was 70 lb.

These tests showed that both a slightly plastic dark brown sandy silt and a dark brown sandy clay of low plasticity could be compacted to 95 percent of standard Proctor density by four passes of the pneumatic rollers on 12-in. lifts. In contrast, when a heavy sheepsfoot roller with 675 lb

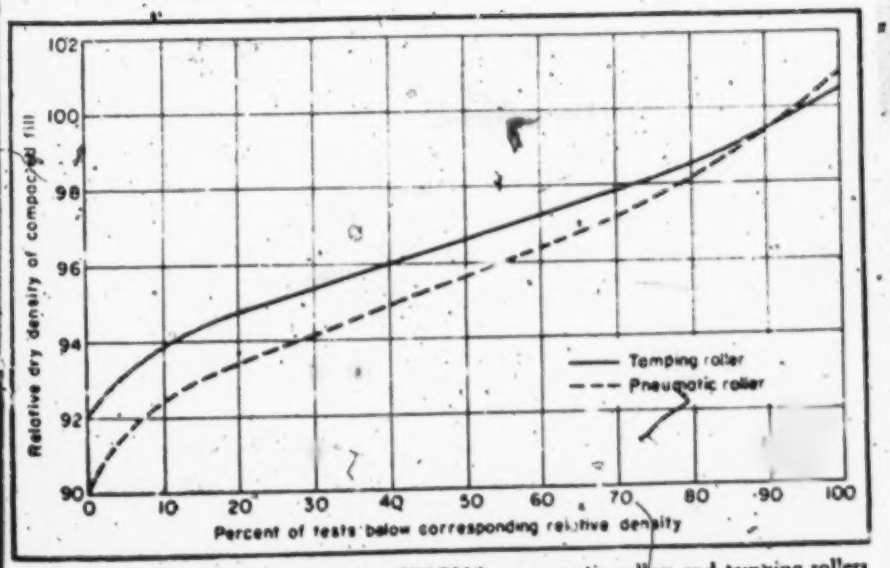

FIG. 3. COMPARISON OF COMPACTION by pneumatic rollers and tamping rollers at Isabella Dam where the modified Proctor method of determining density was used. Average densities for the pneumatic work were slightly lower than for sheepsfoot.

As the contractor elected to add moisture to the impervious material on the fill rather than in the borrow pits, it was necessary to decrease the lift thickness to 6 in. in order to obtain uniform mixing of the soil. Compaction of the core material was therefore accomplished by four passes of the roller with its weight reduced to 88,000 lb.

Here also, very satisfactory results were obtained, 134 samples of impervious fill giving 91 percent of modified Proctor density, with 61 percent above 90 and 23 percent above 93. Because of the increased compactive effort represented by the modified tests, all tests were above

roller on 18-in. layers.

A comparison of 224 density tests on impervious fill compacted with sheepsfoot rollers, which was done under the first contract, with 250 tests on similar fill in the closure section of the auxiliary dam, which was built with pneumatic rollers, is shown on Fig. 3. The average density for the sheepsfoot work was 90.4 percent of modified Proctor density, while the average for the pneumatic rollers was 95.5 percent. With both rollers, 70 percent of the tests were above 94.

The contractor—a combination of

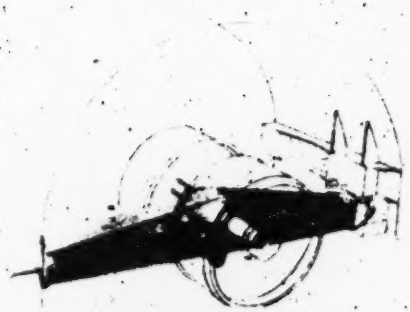

FIG. 5. PHANTOM DRAWING to show method of mounting each pair of wheels on the Ferguson unit. Mounting of the Bros model is similar.

Tamping roller specifications also have been changed to give the roller weight in pounds per linear foot rather than pounds per square inch of foot in contact with the ground. This avoids a controversy over the number of feet actually on the ground for those rollers having staggered arrangement of the feet. The loaded weight in pounds per linear foot of drums is usually specified as 8,500 and the empty weight as 2,000 in order to provide for adjustment in the field which will permit optimum compaction.

The same effect is obtained in the rubber-tired roller specification by the variation in tire pressure and wheel load. The allowable spacing between wheels is specified to prohibit equipment which would lose much of the effective compacting force by lateral shear or ting of the fill.

INDEX

	PAGE
Respondent's statement of the case	1
Argument	4
Conclusion	8
Notice of service	9

AUTHORITIES CITED

Cases:

E. J. Brooks Company v. Stoffel Seals Corporation, decided May 4, 1959, 121 U.S.P.Q. 333	8
Great A & P Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147	3, 4, 5, 8
Green County v. Quinlan, 211 U. S.	6
Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530	7
Owens v. Union Pacific Ry. Co., 319 U. S. 715	6
United States v. Fleischman, 339 U. S. 739	6

Statutes:

35 U. S. C. 103	7, 8

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The present Petition for Certiorari should be denied, because— (1) it fails to accurately and completely state the case, (2) it is partially based on matter which is not of record, (3) it does not present the "special and important reasons" required by this Court's rule 19, and (4) it asserts grounds for the writ which are unsound and inconsistent with existing statutes and case law on the question of patentability.

RESPONDENT'S STATEMENT OF THE CASE

For purposes of convenience and, following the procedure used by petitioner, to avoid confusion, reference is made to the appendix to petitioner's brief, i.e., (App. p.—) rather than to the record used below.

This is a suit brought by respondent for infringement of its patent on a pneumatic roller compactor for compacting earth preliminary to the building of roads, airport runways, dams, etc., thereon "where deep penetration and uniform maximum density are important objectives" (Pl. Ex. 11, App. p. 32).

The trial court found that the petitioner, defendant below, admitted infringement at the trial (App. p. 16) and conceded commercial success of patented structure (App. p. 17). The court in fact found (App. p. 17) that the manufacturer of the infringing device "did actually copy the plaintiff's structure". The petitioner's only asserted defense in the courts below has been alleged invalidity of the patent, a question in which petitioner, of course, has the burden of proof. It failed to sustain this burden in a full trial before the district court whereby judgment was entered against petitioner on December 16, 1957 (App. p. 20), enjoining petitioner from further acts of infringement and awarding respondent profits and damages. A writ of permanent injunction issued December 31, 1957.

The trial court's judgment was in all respects affirmed by the Circuit Court of Appeals on February 19, 1959, after full briefing and oral argument by the parties (App. p. 19). These claims vary in scope and the substance of the invention has not been fully presented in petitioner's statement of the case. Petitioner offers an over-simplified description of the invention (p. 4) and then follows this by quoting only claim 1 of the patent (p. 5). Actually the description referred to is not even consistent with the single claim quoted as it fails to include the important structural element of that claim described as:

> "a draft beam extending longitudinally through the lower part of the body, centrally thereof, said draft

beam traversing said arched recess between two of such wheels and rigidly connecting opposite wall portions of the recess".

It is accordingly submitted that petitioner's self-styled description of the invention on page 4 is incomplete and is simply an effort to minimize and simplify the patented structure, a real understanding of which can be obtained only by referring to all four claims of the patent itself.

Also in its statement of the case (p. 4) and, in substance, in its argument (p. 7), petitioner matter-of-factly states that all of the elements of the patented compactor "are admittedly old in the prior art". Such statements are unsupported by the record. There has been no such admission by respondent and no such finding by either court below.

The petitioner's "questions presented" and "statement of the case" are also inaccurate and misleading in other respects. In question No. 1 (p. 2) and on page 6 the petitioner infers that "imposing size and supposed complexity of the patented earth compacting roller" was the sole criterion used by the Circuit Court of Appeals to distinguish this case from *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147. While the court did mention these factors, its decision clearly sets forth other reasons for distinguishing the case from the *A & P Case* and these will be later discussed herein.

Petitioner's question No. 2 (p. 3) is based on a completely false premise in its suggestion that the construction held patentable by the Circuit Court of Appeals was "an arrangement suiting government specifications". There are no such government specifications in the record. The article submitted by petitioner (App. p. 35) for judicial notice by the court on this matter will be considered in respondent's Argument.

ARGUMENT

Petitioner, in its first argument, endeavors to show a parallelism between the decisions of the lower courts in this and the *A & P Case*. It is true that in both cases those courts held the respective patents concerned valid and infringed. However, there is a wide divergence in the weight of the facts and in the reasoning of the courts supporting the holding of validity in the two cases. Petitioner alleges that the Circuit Court of Appeals distinguished this case from the *A & P Case* merely because there was "a vast difference in the complexities of the two inventions".

This statement of the Circuit Court is indeed significant even when petitioner carves it out of context. But its full meaning can be truly appreciated only when we look at the complete statement of the Court (App. p. 25), which reads:

> "It would seem that the opinion of the Supreme Court in Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corp., 340 U.S. 147, is not applicable here because of the vast difference in the complexities of the two inventions. There the condemned invention consisted simply in opening up the apex of the equivalent of an ordinary pool ball rack so that the legs of the triangle became parallel to each other and perpendicular to the base, the open rack being merely hand pushed along an elongated table in the handling of food sold in stores. The pushing element was not automatic—not even mechanical.
>
> "Here as has been previously shown, the huge *patented device was highly complicated and most ingeniously designed*; and it served a purpose not theretofore known for practical requirements in its field" (Italics supplied).

The Circuit Court below is the very Court reversed by the decision of this honorable Court in the *A & P Case*. Thus

being fully cognizant of its error in that case the Court now clearly and explicitly distinguishes the invention here involved from the *A & P* device. Not only is there "a vast difference in the complexities of the two inventions" but the Bros roller is characterized as being "highly complicated and most ingeniously designed".

Moreover the Court clearly follows the law of the *A & P Case* which requires that the lower court find that the old elements perform a different function in the combination than they performed out of it. Judge Allen (App. p. 26) states that the following principles are "applicable to the instant case":

> "In order to secure a true and patentable combination of old elements, the elements must coact to produce the result achieved, the result must be new and useful, and the method of operation must be new.
>
> "If the method of operation is new and the result is new, *the old elements perform a new function in their new environment.*"

Accordingly, the court below not only specifically distinguishes the inventive quality in the invention involved here from that in the *A & P Case* but adopts the standard of invention laid down by this Court in that case by holding that in the claimed combination a new result is obtained and the elements perform a new function in their new environment.

The petitioner bases its second ground for granting certiorari solely on an alleged publication appended to the petition for judicial notice by the Court. Neither the article nor the argument purportedly supported by it was presented to either court below. Thus petitioner is now asking this Court to review a question which doesn't exist on the

record. It is submitted that this request is improper and beyond the intended scope of review by certiorari.

In *Green County v. Quinlan*, 211 U.S. this court stated:

> "The defendant's counsel has not confined his argument to the questions presented by the record, and it seems expedient, therefore, simply to determine the questions deemed to arise on the record and stop there."

On other occasions this court has held that since the court of appeals did not deal with a question it would not decide it. *Owens v. Union Pacific Ry. Co.*, 319 U.S. 715; *United States v. Fleischman*, 339 U.S. 739.

It is undoubtedly not improper to ask this Court to take judicial notice of certain non-controversial matters such as statutes or the like. But here the Bertram article is an entirely unauthenticated publication nakedly attached to the petition, in an effort to cast a cloud over this record. Moreover it is noted that the article was published in April 1953 or nearly three and one-half years *after* the filing date of the application for the patent in suit, and that the government "specifications" mentioned therein, which appear to merely list desirable characteristics rather than structure for such a machine, were in fact written *after* the invention of the patent in suit had been made. Accordingly, even if the article had been properly introduced and admitted to the record below it would lack any probative value whatsoever.

The assertions contained in Argument II on pages 10 and 11 of the petition are thus completely false. The alleged issuance of "specifications" by the government agency, if true, in fact amounted to an acceptance and recognition of the value of the Bros construction, thus lending support to the patentability thereof.

The article concerned is accordingly clearly irrelevant to the issues now before this honorable court and should be disregarded as being outside of the record, unauthenticated, and on its face immaterial to the question of validity.

As its final Argument IV (p. 12) for granting the Writ, petitioner relies on the inexplicable ground that the lower courts made their findings in compliance with the governing statute, namely, *35 U.S.C* 103 (p. 3). The courts held that the patented structure transcended the negative limitation of the statute in regard to patentability by saying that the arrangement "required something more than just ordinary mechanical or engineering skill to accomplish" (App. p. 18) and that it would not "be obvious to those schooled in the art at the time the invention was disclosed" (App. p. 27).

Now the petitioner argues that the lower courts may have erred in finding compliance with statutory patentability as certain other lower courts have construed the cited statute as relaxing the standard imposed by recent decisions. The logic of this approach to grant certiorari in this case is far from sound. The courts below have not in any way indicated reliance on a relaxed standard of invention. Rather they have based their judgments squarely on the standards which have been enunciated by this Court. Construction of *35 U.S.C.* 103 is accordingly a moot question in this proceeding.

Moreover, it has become increasingly clear that the 1952 patent act has not in any way changed the standard of invention. If there were any question about the position of the Circuit Court of Appeals for the Second Circuit, which decided *Lyon v. Bausch & Lomb Optical Co.*, 224 F. 2d 530, relied on by petitioner, on this matter, that question has not been dispelled by the recent decision of that

court in *E. J. Brooks Company v. Stoffel Seals Corporation*, decided May 4, 1959, and thus far reported only in *121 U.S.P.Q.* 333. Here that Court states (footnote 5 of the decision) that the 1952 act "is essentially a codification and not a revision". The Court at page 335 refers to the "level of invention required by statute *and* the Constitution for the grant of a patent monopoly, 35 U. S.C. 103; U.S. Const. Art. 1, § 8", and in an explanatory footnote (3) it quotes the following from the *A & P Case*:

> "It is worth emphasis that every patent case involving validity presents a question which requires reference to a standard written into the Constitution."

The Court also cites cases from six other circuits which have had an opportunity to consider the matter as holding that the statutory test does not change the law. The lower courts are in general agreement that the enactment does not relax the standard established by this Court in the *A & P Case*. Thus there is no need for the Court to now construe this statute, particularly in this case where the Circuit Court has held that the invention meets the even more stringent constitutional standard of patentability.

CONCLUSION

The invention involved in this litigation has been found by the lower courts to be a substantial contribution to the field of compaction. The trial court stated (App. p. 16):

> "I believe this patent is something more than just an aggregation or an assembly of well known elements of the road building art where the ground is to to be densified, or densification is one of the principal accomplishments to be had and compaction is another. There apparently must have been a need for

some sort of marketable machine with all these ingredients and elements that would accomplish what the market and the trade wanted; and the plaintiff fulfilled this in a new and useful way, even though it was necessary to use the prior art and prior art structures to accomplish it."

The Court of Appeals affirmed the district court, holding that the patented device "was highly complicated and most ingeniously designed" and produced a new and useful result where "the old elements perform a new function in their new environment."

Thus the courts below have unequivocally and correctly invoked a constitutional standard of invention in finding the patent valid. The soundness of their decisions precludes any necessity for review by this honorable Court.

The petition for writ of certiorari should accordingly be denied.

Respectfully submitted,

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NOTICE OF SERVICE

This is to certify that five copies of this brief have been served on Mr. Warley L. Parrott, counsel for petitioner, by air mailing the same to him at his last known address, this ——— day of June, 1959.